

Attorney Docket No. AUS9-2000-0655-US1  
Serial No. 09/731,651  
Response to Office Action dated 05/06/2004

## I. REMARKS

### A. Claim Rejections

The Examiner rejected claims 1-7, 9-15, and 17-25 as obvious in view of U.S. Patent No. 6,490,601B1 (issued Dec. 3, 2002) (the "'601 Patent") and U.S. Patent No. 6,065,048 (issued May 16, 2000) (the "'048 Patent").

The Examiner rejected claims 8 and 16 as obvious in view of the '601 patent, the '048 patent, and U.S. Patent No. 6,026,410 (issued Feb. 10, 2000) (the "'410 Patent").<sup>1</sup>

### B. Prior Art References

In general, the '601 Patent is the only reference that the Examiner cites that is relevant to Applicant's independent claims, and thus, is the only such reference described in detail below.<sup>2</sup> The '601 Patent, though, describes an additional prior art method for filling out an electronic form (the "e-wallet" method). Although the Examiner has neither relied upon nor cited the e-wallet method, the e-wallet method appears particularly relevant to the Applicant's claims, and consequently, it also is described below.

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<sup>1</sup> The Examiner cites U.S. Patent No. 6,026,761 and indicates that the Applicant provided this reference. But inasmuch as the Applicant did not provide such a reference, the Applicant assumes that that the Examiner intended to cite U.S. Patent No. 6,026,410, which the Applicant did provide and which was issued to Allen et al.

<sup>2</sup> Higley discloses a process and apparatus for sending and receiving Uniform Resource Locators (URLs) in electronic mail over the Internet. U.S. Patent No. 6,065,048, "abstract." In particular, Higley describes a process for using the MIME standard to categorize electronic mail, and an accompanying process for translating the electronic mail upon receipt, which varies according to the mail's category. The Examiner cites Higley because "Higley mentions *complaints* that can be handled electronically." Office Action from Examiner to Applicant of 5/6/2004, at

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**1. U.S. Patent No. 6,490,601B1**

Markus et al. disclose an apparatus and accompanying processes for filling in web-based forms. U.S. Patent No. 6,490,601B1, at 6:39-40. In particular, Markus et al. describe a server (the "privacy bank") that stores user data and standard merchant fields. *Id.* at 7:1-10. In general, a merchant provides a form, or forms, to the privacy bank. *Id.* at 7:15-20. The privacy bank then maps the fields in the merchant's form to the privacy bank's standard fields. *Id.* at 7:18-21. The merchant also must indicate how the merchant intends to use the data associated with each field (the merchant's "privacy practices"). *Id.* at 14:30-50. The merchant inserts into the form an "external link" to the privacy bank and then publishes the form on the merchant's website. *Id.* at 10:4-6. The privacy bank then maps the merchant's fields to the standard fields, and maps the consumer's data to the standard fields. See *id.* at 14:30-15:17, FIG. 7. The privacy bank also compares the merchant's privacy practices with the consumer's privacy preferences. See, e.g., *id.* at 15:20-40. If the merchant's privacy practices do not exactly conform to the consumer's privacy preferences, then the privacy bank notifies the consumer, and may attempt to resolve the conflict with a real-time "negotiation" between the merchant and the consumer. See *id.* at 15:41-16:8. The privacy bank then reconstructs the merchant's form with the standardized fields, incorporates a JavaScript program into the form that includes instructions for merging the consumer's data with the standardized fields, and transmits the reconstructed form to the browser. See *id.* at 10:8-12, 8:24-27, 11:3-10. If the consumer subsequently

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JavaScript merges the consumer's data with the fields in the form and displays the results in the consumer's browser. *Id.* at 11:10-62.

## 2. The e-Wallet Method

The term "e-wallet" describes a generic tool that facilitates filling in electronic forms, particularly web-based forms. *See* U.S. Patent No. 6,490,601 B1, at 3:15-40; Megan Barnett, *It's the year of the e-wallet*, CNN.com, at <http://www.cnn.com/TECH/computing/9907/01/cwallet.idg/> (July 1, 1999); Beth Cox, *eWallet signs Agreements with Beyond.com, Presents.com, Internetnews.com*, at <http://www.internetnews.com/cc-news/article.php/33131> (December 28, 1998); *eWallet Offers Easier Online Shopping*, at <http://news.earthweb.com/cc-news/article.php/32321> (November 25, 1998).<sup>3</sup> The tool comprises a computer program, which a user must install on a personal computer, and a database, in which the user stores personal information (e.g. name, address, and credit card number). *Id.* If the user subsequently visits a website with an electronic purchase form, the user can activate the e-wallet program, which displays the information in the database. The user then "drags" the appropriate information from the display to the web browser, and the e-wallet program fills in the form. *See id.*

## C. Applicant's Response

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explicitly the defining terminology already presented in the descriptive text. In particular, the Applicant has amended claims 1 and 12 to include terminology that describes the "set of rules."<sup>6</sup> The Applicant does not intend to narrow the scope of the original claim by this amendment. The Applicant has included this terminology explicitly merely to demonstrate that, contrary to the Examiner's position, Markus et al. do not disclose "each and every element," *see Verdegaaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP § 2131, in as stated (see, e.g., *Verdegaaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)), ("[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art"). Since the cited reference does not support the rejection, the Applicant requests that the Examiner withdraw the rejection.

The Applicant also has amended independent claim 22 so that it more particularly points out and distinctly claims the subject matter that the Applicant regards as the invention. *See* 35 U.S.C. § 112, para. 2. In particular, the Applicant has amended claim 22 to include the "set of rules" found in the other independent claims. Thus, Markus et al. do not teach or suggest all the limitations of claim 22 as amended, and the Applicant requests that the Examiner withdraw the rejection.

## **2. Amendments to Dependent Claims**

Since Markus et al. do not disclose all the limitations of independent claims 1, 12, and 22,

they cannot disclose all the limitations of any claim that depends upon these claims. To the

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fairly taught by any of the references of record, taken either alone or in combination. Therefore,  
allowance of the present application is in order, and is requested.

Respectfully submitted,

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## It's the year of the e-wallet

July 1, 1999

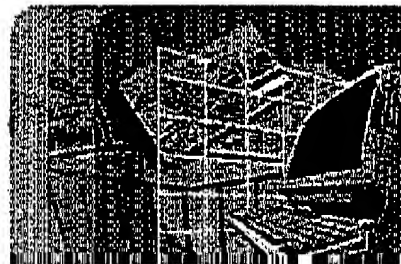
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by Megan Barnett

(IDG) — Shopping online is still harder than it ought to be, at least in part because of the complications involved in paying for the goods you want to buy.

An array of companies have attempted to solve the problem...

software that stores and manages personal data and makes it unnecessary to retype credit-card numbers, addresses and so forth every time you want to make a purchase. To date, e-wallets have not been a great success. But new, improved versions are coming soon. Expect to hear a lot about them.



The next-generation e-wallets will use a newly released standard, the Electronic Commerce Modeling Language. ECML works with any Web-security software and enables electronic wallets to automatically feed customer information into the payment forms of participating merchants.

Visa, MasterCard and American Express (AXP) are spearheading the initiative, with support from Sun (SUNW), Microsoft (MSFT), IBM (IBM), Reel.com and others.

If it can be widely deployed across merchant sites, ECML will change the rules of the game for electronic-wallet providers. What once was a competitive edge — one-click shopping — will become a commodity. And the proliferation of the standard will lower the barriers to entry

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banks, financial-information sites and credit-card companies will likely increase.

Computerworld Minute

As a result, independent, third-party wallet providers will have to come up with services beyond one-click shopping to lure customers.

## FASTER ACCESS:

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San Francisco-based Brodia.com, formerly Transactor Networks, hopes to do just that. Brodia, which launches its "remote-control shopping" e-wallet this week, helped develop ECML with IBM and Visa after its engineers configured a system to read the various checkout forms and procedures that now exist.

## WEB SERVICES:

One-click shopping is just a piece of what Brodia's remote-control shopping service will offer. Free for consumers, Brodia's e-wallet can handle multiple credit-card numbers and shipping addresses. It can also catalog a consumer's favorite shopping destinations and options to receive incentives from these destinations. And it lets consumers store receipts.

Ron Martinez, Brodia's CEO, envisions the service expanding to include bill presentment, home banking, weekly grocery orders and Martinez says: "Future able to keep out unwanted marketing by" indicating interest for special offers from certain merchants." Banks that partner with Brodia can offer deals on credit cards for specific purchases. Brodia will share revenue with merchants and banks from transactions generated through its service.

Brodia isn't alone in its e-wallet quest. Older electronic-wallet vendors, such as Idealab's eWallet, are working to expand their products' functionality and services. Portals are hoping to capture audiences with similar offerings, though none yet has launched with a set of services comparable to Brodia's. Major commercial banks like Wells Fargo are also examining the space. And Sabeer Bhatia, founder of Hotmail, has unveiled details of his new venture, Arzoo, which is strikingly similar to Brodia.

"We believe 1999 is the year of the wallet," says Steve Ryan, Visa's senior VP of emerging technologies. This version of ECML is just the first of many to come, he adds. As other payment solutions become more widely used, ECML will add those forms to its functionality.

The creation of ECML marks the culmination of what could be a new category in online retailing. The electronic wallet is evolving into a... in their e-wallets. Add your own personalized shopping mall and you're an empowered online shopper. Which, of course, is just what the credit-card companies want.

## The Wallet Market Gets Crowded

Wallet Vendor	Service Details

<http://www.cnn.com/TECH/computing/9907/01/ewallet.idg/>

America Online	Works within America Online shopping only
Brodia.com	Direct-marketing tool, travels with a consumer across sites
CyberCash	Marketed to the CyberCash merchant customer base as an e-commerce payment gateway
Gator.com	Direct-marketing tool, dubbed an "online companion" for storing passwords and credit cards
IBM	Part of the IBM Payment Suite of products for corporate customer
Microsoft	Expected to launch in late summer; details unclear
Trintech	Single card resides on the desktop or a toolbar; multiple-card service can reside on a server or desktop
Yahoo	Works within Yahoo shopping only

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